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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,595	10/04/2000	Ernest S.Y. Wong	391442004300	8464

25225 7590 10/29/2002  
MORRISON & FOERSTER LLP  
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SUITE 500  
SAN DIEGO, CA 92130-2332

EXAMINER
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LIU, HONG

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 10/29/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/678,595

Applicant(s)

Wong et al.

Examiner

Hong Liu

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

THE REPLY FILED Sep 10, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**THE PERIOD FOR REPLY** [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s):  
US 4,921,963
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 1, 3-7, and 14-20
- Claim(s) withdrawn from consideration: \_\_\_\_\_
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1
10. ☐ Other: \_\_\_\_\_

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***Attachment to the Advisory Action***

***Status of the Application***

Applicant response in paper No. 13 is hereby acknowledged. Claims 1, 3-7, and 14-20 are pending in this application.


The amendment filed on September 10, 2002 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: rejection to claims 1, 3-7 and 14-20 under 35 U.S.C. 103(a) as being unpatentable over Murrer et al. (US 5,665,771) is maintained for reasons of previous office action which are incorporated herein by reference. Applicants' arguments citing case laws are fully considered and are not found persuasive. Unlike the situation in *Baird*, the Murrer reference not only generically teaches that Z can be a 5-, or 6- monocyclic amine, it also discloses specific species, i.e., pyridine. Although the amended claims eventually exclude pyridine from the genus, the generic teaching of Murrer coupled with its specific showing of a 5- or 6-membered unsaturated heterocyclic amine would provide sufficient motivation for one skilled in the art to select the claimed compounds from the genus in the reference to arrive at the present invention. Applicants also argue that the claimed compounds have improved solubility and antitumor activity. However, applicants have not shown side by side that the claimed compounds are superior to the reference compounds in the treatment of cancer.


Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. If attempts to reach the examiner by the phone are

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unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for official business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

Hong Liu  
October 26, 2002

  
**BRUCK KIFLE, PH.D.**  
**PRIMARY EXAMINER**

 **Mukund Shah**  
**Supervisory Patent Examiner**  
**Art Unit 1624**